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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/799,795 | 03/12/2004 | Masaya Fujita | 17528 | 8301 |
| 23389 7590 12/24/2008 SCULLY SCOTT MURPHY & PRESSER, PC 400 GARDEN CITY PLAZA SUITE 300 GARDEN CITY, NY 11530 | | | | |
| EXAMINER | | | | |
| SMITH, PHILIP ROBERT | | | | |
| ART UNIT | | PAPER NUMBER | | |
| 3739 | | | | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/799,795

Applicant(s)

FUJITA, MASAYA

Examiner

PHILIP R. SMITH

Art Unit

3739

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 October 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11, 13, 14 and 16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11, 13, 14 and 16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

- [01] A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/30/08 has been entered.

Claim Rejections - 35 U.S.C. 112, Paragraph Two

- [02] The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
- [03] Previous rejections under 35 U.S.C. 112 are withdrawn in view of the amendments of 10/30/08.

Claim Rejections - 35 USC § 103

- [04] The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
- [05] Claims 1-3, 5-6, 8-9, 11, 13-14, 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wang (6,911,916) in view of Brant (6,278,975).
- [06] With regard to claims 1,13,16:
- [06a] Wang discloses an endoscope system comprising:
- a voice input unit which inputs voice in a natural phrase ("microphone 34," 3/35);

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- a voice and character converting means ("feature extractor 38," 3/38) which recognizes the voice inputted and converts the inputted voice into character data;
- comparison data storing means (comprising "master controller 12" and "slave controller(s) 14," 4/55-59) for prestoring, as comparison data with a hierarchal structure, first command character trains for specifying each of a plurality of devices in a storage area corresponding to a first hierarchy in a memory in a system controller for controlling the plurality of devices ("selection command" 3/44), and second command character trains related to respective functions and instructions of the plurality of devices in a storage area corresponding to a second hierarchy subordinate to the first hierarchy ("control commands" 7/21);
- a monitoring unit ("decoder 40," 3/40) which monitors the first and second command character trains that are stored in the comparison data storing means and the character data that is converted by the voice and character converting means;
- an executing unit (comprising "master controller 12" and "slave controller(s) 14," 4/55-59) which executes an instruction ("control commands," 6/15-23) previously allocated to the combination of the command character trains that correspond to the first and second command character command trains, upon detecting, in the converted character data, the command character train from the first and second command character trains for a predetermined time interval in accordance with the hierarchical structure of the preset comparison data.

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- [06b] Wang does not disclose a verification request means for issuing an audible request when the instruction is predetermined to require verification prior to execution.
- [06c] Brant discloses a "computer 18" which "identifies a valid command in an audio output signal," "generate[s] a confirmation message before executing the identified command," and "wait for acknowledgment from the operator before executing the command" (7/54-8/2). At the time of the invention, it would have been obvious to a person of ordinary skill in the art to include the verification request means disclosed by Brant in the invention of Wang. A skilled artisan would be motivated to do so in order to "increase the safety of the system, particularly in surgery, because the surgeon can cancel a verbal command" (7/65-8/2).
- [07] With regard to claims 2, 5 & 8: The plurality of devices disclosed by Wang comprise an electric cautery device ("electrocautery device 18," 2/51) and a gas insufflator ("insufflator 24," 2/58).
- [08] With regard to claims 3, 6 & 9: The command character trains include character trains which designate a plurality of output formats ("control commands," as noted above) of the plurality of devices.
- [09] With regard to claim 11: Wang discloses that the executing unit executes the instruction ("control commands," as noted above) allocated to the combination of the command character trains and thereafter displays the executed result of the instruction (via "video monitor 86," 8/16).

- [10] With regard to claim 14: as noted above, Wang discloses a display step of displaying an executed result of the instruction after executing the instruction allocated to the combination of the command character trains in the executing step.

Additional Claim Rejections - 35 USC § 103

- [11] Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wang in view of Brant and in further view of Tvinneriem (2003/0139789).
- [12] As noted above, Wang in view of Brant discloses "voice control" of "any electrically controlled device utilized in an operating room," including "electrocautery device 18" (2/50-3/30). The voice control disclosed by Wang in view of Brant is broken down into "selection commands," in which a user selects a single device from among a plurality of devices, and "control commands," through which the selected device, for example, an electric cautery device, is controlled.
- [13] Wang in view of Brant does not disclose the specific "control commands" to which the "electrocautery device 18" is responsive. More particularly, Wang in view of Brant does not disclose that the character trains which designate the plurality of output formats of the electric cautery device include an output system designating group [monopolar / bipolar], an incision mode designating group [urology / mix1 / mix2 / pure], an incision output designating group [up / down], a clotting mode designating group [soft / soft A], and a clotting output designating group [up / down].
- [14] Tvinneriem discloses an electric cautery device which is operable in "bipolar and monopolar modes" ([0146]). Tvinneriem additionally discloses that the electric cautery device is operable in "at least two different modes, an ablation mode and a subablation or thermal heating mode," necessitating a "lower voltage" ([0132]).

- [15] Since one of ordinary skill in the art would be expected to turn to the prior art to "fill in the gaps" when reducing the Wang in view of Brant reference to practice, the ordinarily skill artisan would be thus motivated to use what is known in the art of electric cautery devices. Use of such known features with the electric cautery device of Wang in view of Brant would therefore be obvious and involve no inventive effort.

Additional Claim Rejections - 35 USC § 103

- [16] Claims 7,10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wang in view of Brant and in further view of Kraft-Kivikoski (6,402,714) for the reasons set forth in the Office action of 9/5/2006.
- [17] As noted above, Wang in view of Brant discloses "voice control" of "any electrically controlled device utilized in an operating room," including "insufflator 24" (2/50-3/30). The voice control disclosed by Wang in view of Brant is broken down into "selection commands," in which a user selects a single device from among a plurality of devices, and "control commands," through which the selected device, for example, an electric cautery device, is controlled.
- [18] Wang in view of Brant does not disclose the specific "control commands" to which the "insufflator 24" is responsive. More particularly, Wang in view of Brant does not disclose that the character trains which designate the plurality of output formats of the gas insufflator include an air-supply on/off designating group [start / stop], a set pressure designating group [up / down], an air-supply mode designating group [high / middle / low], and a set fluid amount designating group [up / down].

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- [19] Kraft-Kivikoski discloses a gas insufflator which can inherently be started and stopped. Kraft-Kivikoski additionally discloses that the gas insufflator is to regulate pressure and supply air ("pressure regulator 18," 7/27-65).
- [20] Since one of ordinary skill in the art would be expected to turn to the prior art to "fill in the gaps" when reducing the Wang in view of Brant reference to practice, the ordinary skill artisan would be thus motivated to use what is known in the art of gas insufflators. Use of such known features with the gas insufflator of Wang in view of Brant would therefore be obvious and involve no inventive effort.

Response to Arguments

- [21] Applicant's arguments filed 10/30/08 have been fully considered but they are not persuasive.

Conclusion

- [22] Any inquiry concerning this communication or earlier communications from the examiner should be directed to Philip R Smith whose telephone number is (571) 272 6087 and whose email address is philip.smith@uspto.gov. The examiner can normally be reached between 9:00am and 5:00pm.
- [23] If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on (571) 272 4764.
- [24] Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on

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access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-

217-9197 (toll-free).

/Philip R Smith/

Examiner, Art Unit 3739

/Linda C Dvorak/

Supervisory Patent Examiner, Art Unit 3739